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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,907	01/14/2004	Nick Galea	TJK/442	3107
27717	7590	02/22/2008		
SEYFARTH SHAW LLP				
131 S. DEARBORN ST., SUITE 2400				
CHICAGO, IL 60603-5803				
EXAMINER				
PATEL, HARESH N				
ART UNIT		PAPER NUMBER		
2154				
MAIL DATE		DELIVERY MODE		
02/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/756,907

Applicant(s)

GALEA, NICK

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-10 are subject to examination.

Response to Arguments

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection, necessitated by the applicant's amendment to the claims.

Response to Amendment

3. The amendment to the specification including title of this application under examination, dated 11/26/2007, is acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-4 and 8-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. The claims 1-4 contain "means" that are not limited to hardware. Claims 8-10 claim a computer-readable medium, which should be computer storage medium (i.e., limited to hardware).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "sufficiently low" in claims 1, 5 and 8 is a relative term, which renders the claim indefinite. It is not apparent what probability is considered sufficiently low versus not sufficiently low.

The term "sufficiently high" in claims 4, 7 and 10 is a relative term, which renders the claim indefinite. It is not apparent what probability is considered sufficiently high versus not sufficiently high.

Further, "probability is sufficiently low that the incoming message is an unsolicited message" of claims 1 and 8 contradicts with "probability is sufficiently high that the incoming message is an unsolicited message" of claims 4 and 10.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by 2005/0172213 Ralston et al. (Hereinafter Ralston).

8. Referring to claim 1, Ralston discloses a system of regulating receipt of electronic mail comprising: capturing means to capture an outgoing electronic mail message (e.g., page 2); outgoing electronic mail analysing means to determine an electronic mail address of at least one intended recipient of the outgoing electronic mail message (e.g., page 2); list updating means to update a pass list of electronic mail addresses with the at least one intended recipient of the outgoing electronic mail message (e.g., page 2); incoming mail capture means to capture incoming electronic mail messages; incoming electronic mail analysing means to determine whether an electronic mail address of a sender of the incoming electronic mail message is a member of the pass list and to forward the incoming message to an intended recipient when the address of the sender is a member of the pass list (e.g., page 4); and analysing means to determine a probability that the incoming message is an unsolicited message when the address of the sender is not a member of the pass list and for forwarding the incoming message to the intended recipient when the probability is sufficiently low that the incoming message is an unsolicited message (e.g., page 5).

9. Referring to claim 2, Ralston discloses the claimed limitations as rejected as above. Ralston also discloses wherein the list updating means includes dating means to date members of the pass list with a date on which a message was last sent to the member (e.g., page 4).

10. Referring to claim 3, Ralston discloses the claimed limitations as rejected as above. Ralston also discloses pass list purging means to purge the pass list of members to which a message has not been sent for a predetermined period of time (e.g., page 5).

11. Referring to claims 4, 7, 10, Ralston discloses the claimed limitations as rejected as above. Ralston also discloses deletion means to delete an incoming message for which the analysing means determines the probability is sufficiently high that the incoming message is an unsolicited message. (e.g., page 5).

12. Referring to claim 5, Ralston discloses a method of regulating receipt of electronic mail (e.g., page 2) comprising the steps of: capturing an outgoing electronic mail message (e.g., page 2), analysing the outgoing electronic mail message to determine an electronic mail address of at least one intended recipient of the outgoing electronic mail message (e.g., page 2); updating a pass list of electronic mail addresses with the at least one intended recipient of the outgoing electronic mail message (e.g., page 2); capturing an incoming electronic mail message (e.g., page 2), analysing the incoming electronic mail message to determine whether an electronic mail address of a sender of the incoming electronic mail message is a member of the pass list (e.g., page 4); passing the incoming electronic mail message to an addressee when the electronic address of the sender of the incoming message is a member of the pass list (e.g., page 4); filtering the incoming message to analyse a probability that the incoming message is an unsolicited message when the address of the sender is not on the pass list (e.g., page 5); and

when the probability is sufficiently low that the incoming message is an unsolicited message forwarding the message to the addressee (e.g., page 5).

13. Referring to claims 6 and 9, Ralston discloses the claimed limitations as rejected as above. Ralston also discloses wherein the step of updating a pass list includes updating the pass list with the latest date on which a message has been sent to an address, for subsequent purging of addresses to which messages have not been sent within a predetermined period of time (e.g., page 4).

14. Referring to claim 7, Ralston discloses the claimed limitations as rejected as above. Ralston also discloses wherein the incoming message is deleted when the probability is sufficiently high that the message is an unsolicited message (e.g., page 5).

15. Referring to claim 8, Ralston discloses a computer-readable medium comprising code means for regulating receipt of electronic mail comprising the steps of claim 5 (e.g., page 2).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Haresh Patel/

HARESH PATEL

PRIMARY EXAMINER

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2/16/08